

REMARKS

Claims 1-13 are pending in this application.

Applicants Summary of Telephone Interview

Applicant's representative would like to thank Examiner Ashraf and his supervisor for the courtesy extended during the telephone interview conducted on Tuesday, December 22, 2009, at 3:30pm. During the interview Applicant's representative and the Examiners discussed the nature of the Restriction Requirement that was issued in the subject application. Applicant's representative asserted that the Restriction Requirement was improper and requested withdrawal of the requirement. Applicant's representative further requested guidance from the Examiner on how to properly respond to the Restriction Requirement in view of the confusing nature and lack of identification of claims associated with the identified species. No agreement was reached with the Examiners regarding the properness of the Restriction Requirement. However, Examiner Ashraf did provide additional guidance regarding the sets of claims associated with the species identified in the Restriction Requirement enabling Applicant to properly respond to the Restriction Requirement

Election of Species with Traversal

Applicant respectfully elects to continue prosecution on claims 1 – 4, 6 and 8 – 13 which corresponds to Species 1 set forth on page 2 of the restriction requirement. Applicant respectfully withdraws claims 5 and 7 from consideration in the present application. However, for the reasons presented below Applicant respectfully traverses the Requirement for Restriction because it is improper.

In the subject application, the Examiner has now identified three species as being independent and/or distinct inventions necessitating a Restriction Requirement. The Restriction Requirement, on page 2, identifies three species and provides citations to the portions of the specification which describe the alleged three species. Applicant has reviewed the cited portions of the Specification and, after discussion with the Examiner, the identified species correspond to the following claim sets:

Species 1: Claims 1 – 4, 6 and 8 – 13

Species 2: Claims 1, 2, 5, 6 and 8 – 13

Species 3: Claims 1, 2 and 6 – 13

Additionally, on page 4 of the Restriction Requirement, the Examiner indicates that there currently are no generic claims present in the application. However, as indicated above, the identified species correspond to different dependent claims that depend from independent claim 1. Therefore, Applicant respectfully disagrees with the assertion made in the Restriction Requirement that no generic claim currently exists. Specifically, Claim 1 is a generic claim that includes a “communication protocol providing for a return transmission to said sender of **at least one parameter of the protocol** normally targeted at conditions of communication of said contents in said network between said sender and said receiver”. The claims that depend from claim 1 further define the “at least one parameter”. Thus, contrary to the assertion on page 4 of the restriction requirement, claim 1 is a generic claim and no restriction of species is necessary. Additionally, the feature being further defined by the dependent claims relates to different parameters of the communication protocol that facilitate the adjustment of the bitrate of a stream of contents.

According to 37 CFR 1.142(a), “[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action”. Section 803 of the MPEP entitled “Restriction – When Proper” sets forth the instances when restriction under 37 CRR 1.142 is proper and should be made. Section 803 states that “[i]f the search and examination of **>all** the claims in an **<** application can be made without serious burden, **the examiner must examine **>them<** on the merits**, even though **>they include<** claims to independent or distinct inventions”.

Applicant respectfully submits that Restriction Requirement issued in the subject Application is improper because the search and examination on the merits did not and does not pose a serious burden on the Examiner. The subject application has received three Office Actions, a Non-Final Office Action issued on August 19, 2008, a Final Office Action issued on January 21, 2009 and a further Non-Final Office Action on June 9, 2009. In all of the Office Actions issued in this case, the Examiner has effectively searched and examined every claim in the Application including the claims which he now considers to be independent and distinct invention. In response to each Office Action, Applicant has responded with claim amendments and remarks supporting patentability of the claims. However, none of the responses by Applicant has materially altered the claims which are now alleged to represent independent and distinct inventions. In each of the three Office Actions issued, the Examiner has failed to identify any claims, all of which were originally filed, as being drawn to independent and distinct inventions. As the Examiner has previously searched and examined these claims on three separate occasions, Applicant respectfully submits that the issuance of a Restriction Requirement is improper because the Examiner has implicitly acknowledged that no serious burden exists in searching the claims of the subject application. Therefore, in accordance with MPEP §803, the issuance of this restriction requirement is improper.

Additionally, Applicant respectfully submits that the issuance of the Restriction Requirement is improper because the Examiner has not made the prima facie case supporting the Restriction Requirement. MPEP §808.01 states that "The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given. For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed." Applicant respectfully submits that the Restriction Requirement fails to provide any such reason of justification. Instead, and contrary to the requirements set forth in MPEP §808.01, the Examiner has merely set forth conclusory statements and reasons why

the species as claimed are not connected in at least one of design, operation or effect as required by MPEP 802.01. Furthermore, MPEP §802 states that

“the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required. Thus the examiner must show by appropriate explanation one of the following:

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.”

Applicant respectfully submits that the Examiner merely identifies what each species does and refers back to a section in the specification on which the restriction is based and states that the identified species are “not connected...which is clearly evidenced by” the particular pages cited. Applicant respectfully submits that this assertion fails to support the conclusion that the claims are either independent or distinct. The pages cited by the Examiner that are associated with the particular species include descriptions of alternative mechanisms for use in altering the bit rate of a data stream. There is nothing in these cited sections (or elsewhere) that supports the conclusion by the Examiner that these methods are distinct and not connected in at least one of design, operation or effect. Moreover, the mere identification of different mechanisms for accomplishing a singular goal is not sufficient to support the Requirement for Restriction under 37 CFR 1.1.42 and explained in Chapter 800 of the MPEP.

In view of the above remarks, Applicant respectfully submits that the Examiner has failed to make a prima facie case to support the Requirement for Restriction. Specifically, the Examiner has made mere conclusory statements supporting the requirement and has not shown that there would be a serious burden placed on the Examiner in searching and examining the subject application. As the claims in the subject application which are now alleged to be independent and distinct from one another have been searched and examined on three previous occasions and no material amendments were made to those claims during prosecution, it is respectfully submitted that no serious burden would be placed on the Examiner during a further search and examination of the subject Application. Additionally, by mandating an election in this case and asserting that no generic claim exists, the Applicant is prejudiced and forced to pay additional filing fees to obtain protection for alternative features that were, heretofore, viewed and examined as a single invention. It is respectfully submitted that this unfairly prejudicial to Applicant. Thus, as the Examiner has not met his burden supporting the need for Restriction, Applicant requests reconsideration of the Restriction Requirement and further requests that the Restriction Requirement be withdrawn.

In accordance with MPEP §818.03, the above remarks specifically point out the reasons why the Restriction Requirement has been issued in error. Therefore, should the Restriction Requirement become final, Applicant hereby preserves his right to petition under 37 CFR 1.144 should the restriction requirement become final.

Having fully addressed the Examiner's Requirement for Restriction, reconsideration and withdrawal of the Restriction Requirement are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant's attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

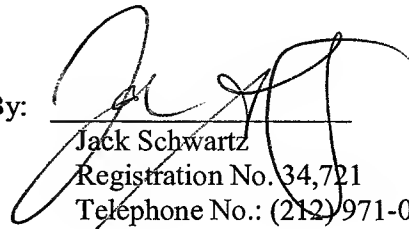
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No additional fee is believed due. However, if an additional fee is due, please charge the additional fee to Deposit Account 07-0832.

Respectfully submitted,
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